

**REMARKS**

Reconsideration and allowance are respectfully requested.

**Remarks Regarding Section 103**

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. *In re Kahn*, 78 USPQ2d 1329, 1334 (Fed. Cir. 2006) citing *Graham v. John Deere*, 148 USPQ 459 (1966). The *Graham* analysis needs to be made explicitly. *KSR v. Teleflex*, 82 USPQ2d 1385, 1396 (2007). It requires findings of fact and a rational basis for combining the prior art disclosures to produce the claimed invention. See id. ("Often, it will be necessary for a court to look to interrelated teachings of multiple patents . . . and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue"). The use of hindsight reasoning is impermissible. See id. at 1397 ("A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning"). Thus, a *prima facie* case of obviousness requires "some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct." *Kahn* at 1335; see *KSR* at 1396.

Claims 1-10 and 13-20 stand rejected under 35 U.S.C. 103 as allegedly unpatentable in view of a combination of Schneider (Applied Catalysis A: General 220 (2001) 51-58) and Choudhary (U.S. Patent 6,437,191). Applicants traverse.

It is the Examiner's position that Schneider teaches the claimed invention except for the use of indium salt as a catalyst and that Choudhary teaches what is lacking in Schneider. Specifically, the Examiner stated that "[t]he prior art, Schneider et al, uses Nafion as the catalyst. The prior art, Choudhary et al, uses indium halide as an acylation catalyst. This is simply substitution of one known element for another to obtain predictable results since the claimed process is an acylation process." Applicants respectfully disagree with this line of reasoning for the instant rejection.

Applicants disagree with the Examiner's position at least because (1) the claimed processes are directed to the use of indium(III) salt as a catalyst, (2) as admitted by the Examiner, Schneider does not disclose the use of indium(III) salt, (3) Choudhary does not disclose indium (III) salts as a catalyst and (4) a combination of Schneider and Choudhary does not teach or render obvious processes involving indium (III) salts as a catalyst.

First, as seen in claim 1, the claimed invention involves a process using indium (III) salts as a catalyst.

Second, as the Examiner has admitted on page 4, lines 7-8 "... Schneider et al does not teach the use of indium salt as a catalyst in their reaction . . ."

Third, Choudhary does not disclose indium (III) salts as a catalyst. Instead, Choudhary uses catalyst of the formula:



(See, for example, Choudhary's Abstract, claim 1, and column 3, lines 12-23; and column 5 lines 13-34). Chemicals of this formula ( $M_xIn_{1-x}A_y(a)/S$ ) was named by Choudhary as "solid catalysts (IV) comprising indium halide" (See Choudhary, column 5 lines 13-34). As it is clear from both the formula and the name, the presence of another metal is essential. In the formula, "x" is defined as "mole fraction of M in the metallic elements in the range from 0.01 to 0.99" (see column 3, line 19-20 and column 5, lines 28-29).

Concrete examples of catalyst cited by Choudhary are mixed Ga/In chlorides, Fe/In chlorides, Zn/In chlorides and Zn/Ga/In chlorides, whereby each of them is on a carrier (see, column 8, line 31 to column 10 line 12, especially column 8, lines 31, 36, 43, 48, 53, 58 and 63, as well as column 9, lines 1, 7, 12 and 17). Because of this, a person skilled in the art, when reading Choudhary, would not get any teaching or hint that indium (III) salts may also be used as catalysts.

Forth, since Schneider does not use indium salt as a catalyst and since Choudhary does not use indium salt as a catalyst (see points two and three above), a

combination of the two references (assuming that they can be properly combined) also does not use indium salt as a catalyst.

For the reason stated above, Applicants submit that Choudhary does not disclose the use of indium (III) salts as a catalyst and a combination of Schneider with Choudhary does not make the present invention obvious. This is, even the use of Choudhary's catalyst in Schneider's reactions (assuming for the sake of this argument only that the two references can be properly combined) would not lead to Applicants' claimed invention.

Withdrawal of the Section 103 rejections is requested because the claims would not have been obvious to one of ordinarily skill in the art when this invention was made.

Applicants submit that these features of their claimed invention are sufficient to distinguish over the cited document so any other incorrect allegations about its disclosure are not disputed here, but the opportunity to dispute them in the future is reserved.

*Conclusion*

Having fully responded to the pending Office Action, Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if additional information is required.

Respectfully submitted,

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